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APPLICATION NO. 08/519,200	FILING DATE 08/25/95	FIRST NAMED INVENTOR JOHNSON	ATTORNEY DOCKET NO. M
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MICHAEL B JOHNSON
160 TERRACE AVENUE
SUITE 1F
HASBROUCK HEIGHTS NJ 07604

34M2/0305

EXAMINER RAAB, S

ART UNIT 3486	PAPER NUMBER
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DATE MAILED: 03/05/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/519,200

Applicant(s)

Johnson

Examiner

Sara Raab

Group Art Unit

3406



☒ Responsive to communication(s) filed on Nov 15, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) 1-11 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 12-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of claims 12-22 in Paper No. 4 is acknowledged.

Claim Rejections - 35 USC § 112

2. Claims 12-22 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

A way in which a claim can be indefinite is where a non sequitur occurs. For example, a claim is inferential and therefore indefinite when it recites "said lever" and there was no earlier reference or no antecedent in the claim to a lever. An indirect limitation also affords a ground of rejection as indefinite. If a "lever" is set forth and, later in the claim, "said aluminum lever" is recited, the claim is rejected as indefinite. If no earlier reference is made to a term, it is said that there is no "antecedent basis" for the term.

a. In claim 12, line 5, "housing means" has been multiply recited from line 4. In line 4, there is no antecedent basis for, "said illumination means." In line 6, there is no antecedent basis for, "the form of a lens."

b. In claims 14, 17, 19, and 22, line 2, there is no antecedent basis for, "the absence of sunlight."

c. In claims 15 and 20, line 2, the use of the pronoun "its" is considered to be indefinite because it is unclear as to what it is referencing. It is unclear what darkened state is being referenced.

d. In claim 21, line 2, the use of the pronoun "its" is considered to be indefinite because it is unclear as to what it is referencing.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12, 14, 15, and 18-20 rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (US 5228767). Johnson shows applicant's invention as claimed including a photochromic lens 20.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13, 16, 17, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of McBain et al (US 4994208). Johnson discloses applicant's invention substantially as claimed. However, Johnson does not disclose said lens being transparent when the fixture is in an energized state and being darkened when in a de-energized state. McBain et al teach the use of a photochromic material which turns from a colored state to a transparent state (or original color) under exposure to white light. See column 1, lines 51-55. For claims 13, 16, and 21, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the lens of Johnson to include the type of material as taught by McBain et al in order to change from a colored state to an uncolored state or original color when the headlight is turned on. For claims 17 and 22, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the lens of Johnson to include the type of material as taught by McBain et al in order to change from one colored state to another colored state when exposed to electromagnetic radiation.


Conclusion

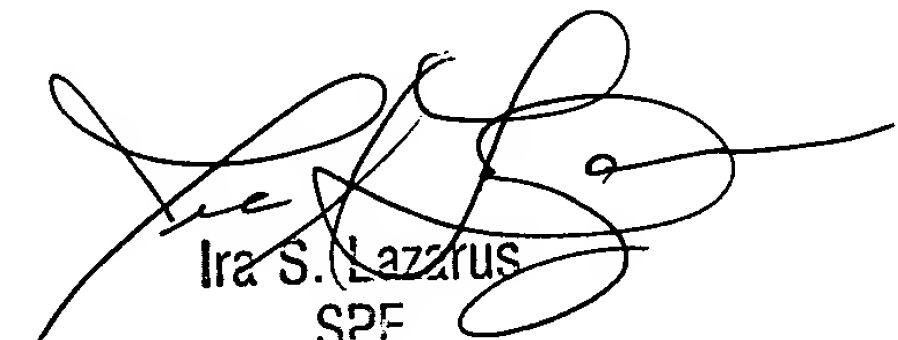
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnson (US 5055982), Baskerville et al (US 4576766), and Kwak et al (US 4909963) show photochromic articles.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Raab, whose telephone number is (703) 308-1942. The examiner can normally be reached Monday - Friday from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus, can be reached at (703) 308-1935. The fax phone number for this group is (703) 305-3463.

Any inquiries of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0861.

Sara Raab 
February 27, 1997


Ira S. Lazarus
SPE
Art Unit 346